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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,583	12/17/2001	David A Stout	T3392-000000	5426

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MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102-3833

EXAMINER

PHAM, MINH CHAU THI

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,583

Applicant(s)

STOUT ET AL.

Examiner

Duane S. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 24, 27, 29 and 30³³ is/are rejected.
- 7) ☒ Claim(s) 20-23, 25, 26, 28, 31 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The previous Office action mailed is withdrawn and vacated, A new action on the merits follows.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,2,7 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller et al(US Patent No.6,737,029)

Miller et al teach an air decontamination system(10) for mail processing including a sealed mailed processing area(40) with an air inlet, vacuum unit(51), work surface(80) wherein air is suctioned downwardly by the vacuum unit, and a filter unit(46). The vacuum unit inherently capable of forming a laminar flow of air as in instant claim 12. Note that such system is a modular construction of units(12,30,40). Miller et al additionally teach an airlock room(52)

4. Claims 15-18,24,27,29,30,33 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller et al(US Patent No 6,737,029).

Miller et al teach a method for removing contaminants from a sealed mail processing area including the steps of providing a work surface (80), introducing an item of mail(col. 5 lines 25-30) onto the work surface in a sealed mail area(40), creating a downward flow of air(col. 3 lines 44-46) into an inlet of a

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vacuum unit(51) in an air outlet through the work surface(80)(col. 4 lines 45-50), and filtering chemical contaminants(ozone) and exiting the air in filter(46).

Inherently the mailroom would have a step of assembling before implementation.

Inherently the vacuum unit is capable of providing a laminar flow of air. The apparatus cleaning mail(col. 5 lines 15-20) as in instant claim 33. Miller et al additionally teach attaching an airlock room(52).

5. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1,6,12 are rejected under 35 U.S.C. 102(b) as being anticipated by anyone of Krainak et al(US Patent No. 6,010,400), Krone-Schmidt et al(US Patent No.5,316,560), Peters(US Patent No. 4,832,717), Japan kokai 63-23119, Japan kokai 62-190338, Japan kokai 6-221634, and German Offen. 3936815.

Krainak et al teach an air decontamination system including a sealed area(13,14), vacuum unit(31), work surface(28) wherein air is suctioned downwardly through the work surface, and filter unit(26). The air flow is in a laminar pattern(col. 4 line 1). The area having a transparent wall(13).

Krone-Schmidt et al teach an air decontamination system including a sealed area(27), vacuum unit(42), work surface(28) wherein air is suctioned therethrough, and filter unit(50). Krone –Schmidt et al additionally teach laminar

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flow(col. 4 lines 45-60). The area having a transparent wall(col.5 lines 45-49)..

Krone-Schmidt et al also teach an airlock(52).

Peters teaches an air decontamination system including a sealed area(10,28), vacuum unit(44) ,work surface(30,38) wherein air is suctioned therethrough, and filter unit(52). Peters also teaches laminar flow(col. 5 line 24). Peters also teaches a transparent wall(78).

Japan kokai 63-231129 teaches an air decontamination system including a sealed area(13), vacuum unit(16), work surface(9,5,3) having air flow therethrough, and filter unit(17).

Japan kokai 62-190338 teaches a sealed area(12), vacuum unit(inherent), work surface(2) having air suctioned therethrough, and filter unit(22,18) Japan kokai additionally teaches laminar flow(abstract).

Japan kokai 6-221634 teach a sealed area,32), vacuum unit(46), work surface(30) having air flow therethrough, and filter unit(44).

German Offen. 3936815 teach a sealed area(clean room in abstract), vacuum unit(60) , work surface(16,10) having airflow therethrough, and filter unit(62).

In the instant claim the phrases "for mail processing" and "mail processing" have not been given patentable weight. Such being intended usage of the apparatus, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the

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claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Furthermore each sealed area of the applied references is capable of the intended function of processing mail, such as sorting mail by hand opening mail upon the work surface, etc. For further reference of intended usage, see MPEP 2114.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over anyone of Japan kokai 62-190338, Japan kokai 6-221634, and German Offen. 3936815 taken together with Burleson(Us Patent No. 4,409,889)

Each of Japan kokai 62-190338, Japan kokai 6-221634, and German Offen. 3936815 disclose the air decontamination system essentially as claimed, *supra* except for the modular construction of the sealed area of removable walls, floors, and ceilings. However, Burleson does disclose a clean room(10) or sealed area having a modular construction of removable walls(16,18,19). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the clean room of any one of Japan kokai 62-190338, Japan kokai 6-221634,

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and German Offen. 3936815 of modular construction as in Burleson in order to ease installation as suggested by Burleson(col.2lines 62-69).

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over anyone of Japan kokai 62-190338, Japan kokai 6-221634, and German Offen. 3936815 taken together with Yehl et al(US Patent No 5,010,777).

Each of Japan kokai 62-190338, Japan kokai 6-221634, and German Offen. 3936815 disclose the system essentially as claimed, supra, except for at least one wall being transparent. However, Yehl et al discloses a transparent wall(col. 11 line 50)in a clean room(300). It would have been obvious to one of ordinary skill in the art at the time of the invention to form at least one wall of transparent material to allow visual inspection of the interior of the clean room.

11. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Japan kokai 62-190338, Japan kokai 6-221634, and German Offen. 3936815 taken together with Saito et al(US Patent No. 4,850,268)

Each of Japan kokai 62-190338, Japan kokai 6-221634, and German Offen. 3936815 disclose the system essentially as claimed except for an air lock room having a second air inlet and filter unit. However, such is known as shown by Saito et al.(2, 11, Fig. 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to include an airlock room as in Saito et al in order to insure ambient air does not contaminate the clean room.

12. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over anyone of . Japan kokai 62-190338, Japan kokai 6-221634, and German Offen. 3936815 taken together with Nelson(US Patent No. 5,074,894)

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Each disclose the system essentially as claimed except for an intercom system or warning device. However, Nelson does disclose an intercom(72) and a warning device(col. 7 lines 1-2) in a clean room(10). It would have been obvious to one of ordinary skill in the art at the time of the invention to include an intercom and warning device in order to alert of possible safety and malfunction scenarios.

13. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over anyone of Japan kokai 62-190338, Japan kokai 6-221634, and German Offen. 3936815 taken together with Kinhead et al (US Patent 5,626,820. 14, 24, 46, 48 & 50 in Fig. 1A', col. 5, lines 15-26*, col. 6, lines 9-17).

Each disclose the system essentially as claimed ,supra, except for a multi-layered filtration system to remove various ranges of particles sizes and a chemical filter. Kinhead et al disclose a multi-layered filtration system of a clean room wherein the filtration system removes various ranges of particle sizes and a chemical filter. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to adopt the multi-layered filtration system as taught by Kinhead et al in order to remove not only the particles from the air stream but also the chemical contaminants produced by the system.

14. Claims 20-23, 25-26,28,31-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is an examiner's statement of reasons for allowance: None of the prior art of record disclose a method of removing contaminants from air in a sealed mail processing area including the steps of dependent claims 20-23,25-

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26,28,31-32 in combination with the features of the independent claim and any intervening claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

16. The Declaration filed on 11-1-04 under 37 CFR 1.131 has been considered but is ineffective to overcome the Miller et al(reference.

The evidence submitted is insufficient to establish a reduction to practice **of the invention in this country or a NAFTA or WTO member country** prior to the effective date of the Miller et al reference, note MPEP 715.07 (c).

The evidence submitted is insufficient to establish a reduction to practice of the invention in that such evidence is not commiserate in scope with the claimed invention. While an embodiment was alleged to be sold such is not sufficient evidence that the invention sought to be patented was sold as evidenced of the invoice Exhibit B wherein only a general allegation that a negative pressure mail sorting and handling room was ordered by the Penzoil-Quaker State Company. Note MPEP 715.02 wherein the "37 CFR 1.131 declaration must establish possession of the whole invention or something falling within the claim". In the instant case, it is indeterminate from the invoice as to what exactly was sold. Furthermore the web page printout Exhibit A fails to provide evidence of reduction to practice in that the web page printout is not commiserate in scope with the claimed invention. The web page printout fails to

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demonstrate the nexus between the claimed elements as recited in the instant claims. For example, there is no evidence that the web page printout presents that such mail sorting NBC Safe room provides a vacuum under the work surface such that air is suctioned downwardly through the work surface.

17. Applicants' arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. Applicants' arguments with respect Miller et al are not persuasive as the declaration under 37 CFR 1.131 is deemed insufficient to antedate the reference, see above.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Other references cited on PTO-892(Notice of References Cited) are considered to be of interest, disclosing similar mail processing systems.

19. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

20. In response to this requirement, please provide relevant information regarding the sale of the embodiment such as dates, what specific embodiment structure was sold, etc. as the evidence presented in the 37 CFR 1.131 declaration gives rise to the question of possible public use or on sale bar rejections under 35 USC 102(a) or 35 USC 102(b).

21. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR

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1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

22. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

23. This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete reply to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duane S. Smith whose telephone number is 571-272-1166. The examiner can normally be reached on 8:30-6:00 M-TH.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Duane S. Smith
Primary Examiner
Art Unit 1724

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4-1-05

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